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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,592	03/30/2001	Katayoun Atefi	END9-2000-0117US1	1255

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EXAMINER
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LOFTIS, JOHNNA RONEE

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/822,592

**Applicant(s)**

ATEFI ET AL.

**Examiner**

Johnna R. Loftis

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a final office action upon examination of application number 09/822,592. Claims 1-9 and 13-19 have been amended. These claims are pending and have been examined on the merits discussed below.

#### ***Response to Arguments***

2. Based on amendments to the claims, previous rejections under 35 USC 112, 1<sup>st</sup> paragraph are withdrawn. Examiner's note: With regard to previous rejections of claims 1-9 and 13-19 under 35 USC 112, 1<sup>st</sup> paragraph, Examiner points out that, as stated in 35 USC 112, 1<sup>st</sup> paragraph, the claims are rejected when they contain subject matter which was not described in the specification in such a way as to enable one skilled in the art ... to make and/or use the invention.

3. Previous rejections of claims 1-9 and 13-19, wherein it was stated that the claims were indefinite, are withdrawn in response to the amendments to the claims. However, new 35 USC 112, 2<sup>nd</sup> rejections are provided below, in response to the newly amended claims.

4. Applicant's arguments with respect to previous rejections under 35 USC 101 have been fully considered and are persuasive. The rejection under 35 USC 101 of claims 1-9 and 13-19 has been withdrawn.

5. Regarding rejections under 35 USC 103(a), Applicant argues that the references fail to show certain features of applicant's invention. Examiner notes that the features upon which applicant relies (i.e., external versus internal evaluation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further more, Examiner construes customer to equate to the user of the system, which inherently includes both internal and external users (customers). The Daskalantonakis reference is based on SEI's Capability Maturity Model (CMM) that is used to evaluate customer satisfaction etc. See the Software Engineering Institute's "A Systems Engineering Capability Maturity Model, Version 1.1", page 3-3.

### ***Claim Objections***

6. Claim 15 is objected to because of the following informalities: Claim 15 is a duplicate of claim 14. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble to claim 1 makes mention of a system for customer evaluation, but the body of the claim does not recite any structure for the system.

Reading the claims as a whole, the claimed invention is a system that contains data structure but there are no physical components recited on which the data in the structure is to be stored, processed or manipulated.

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MPEP 2114 states that an apparatus claim must differentiate itself over the prior art via “structural limitations”. Here, there are no structural limitations. It recites a system as being the invention, but claims that the invention is only comprised of the data structure and the recited functionality, without an apparatus such as a processor or a computer memory on which to store the data within the body of the claim.

Therefore, it is vague and indefinite as to the scope of the claimed invention (i.e., the metes and bounds of the invention). For example, are the claims attempting to patent the system (i.e., the recited functions), the apparatus, or the program per se? If it is the apparatus, what components make up the invention? If it is the underlying program per se, it would raise 101 issues.

The system of claims 1-6 are rejected as being vague and indefinite.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6-9, 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by SEI’s Capability Maturity Model (CMM) as evidenced by:

“Software Capability Evaluation (SCE), Version 2.0”, hereinafter referenced as SCE

and

Daskalantonakis, Michael K. "Achieving Higher SEI Levels" and implementation of SEI maturity model, hereinafter referenced as Daskalantonakis.

As per **claim 1**, SEI's CMM teaches a set of questions pertaining to an information technology service attribute, the set of questions further comprising a focus area of the service attribute, a set of descriptions of the service attribute, a set of considerations of the service attribute and an example of the service attribute (Daskalantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire); an assessment matrix having a plurality of rows and columns, each row corresponding to one information technology service attribute and each column corresponding to a maturity of the information technology service attribute, the maturity of each information technology service attribute determined by a customer's answers to its respective set of questions pertaining to the information technology service attribute (Daskalantonakis - page 1, pages 2 and 3 show the matrix; SCE, page 1-4); and a method to determine if a provider of the information technology service and the customer have a common understanding of the scope and the objectives of the information technology services and to identify any disparity between the expectations of the provider and the expectations of the customer by evaluating the answers to the set of questions and the maturity of the respective information technology service attribute (pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter).

As per **claim 2**, SEI's CMM teaches one of the information technology service attributes is selected from the group consisting of: policies and procedures, team work, consistency of delivery, defect handling, and use of results (Daskalantonakis - page 2, key areas include

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approach (=policies and procedures), deployment (=consistency of delivery) and results (=use of results) and page 6 includes intergroup coordination (=teamwork) and defect prevention (=defect handling)).

As per **claim 3**, SEI teaches answers of the customer to the questions are used to assess the level of customer service and satisfaction as perceived by the customer (SCE, page 3-5)

As per **claim 4**, SEI teaches the levels of maturity of the information technology services further comprise ad hoc, repeatable, consistent, exceptional, and world class (SCE, page 1-4 - initial (=ad hoc), repeatable, defined (=consistent), managed (=exceptional), and optimizing (=world class)).

As per **claim 6**, SEI teaches the assessment matrix further comprises a current maturity level of at least one service attribute and a desired maturity level of the at least one service attribute (Daskalantonakis, page 6, shows goal levels along with current levels).

As per **claim 7**, SEI teaches evaluating the delivery of information technology services to the customer using at least two assessment techniques, a first assessment technique being a matrix of different levels of maturity of service for at least one attribute of information technology services, a second assessment technique being a plurality of questions to determine a customer's perception of the level of maturity of the at least one attribute of information technology services (Daskanlantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire; Daskanlantonakis - page 1, pages 2 and 3 show the matrix; SCE, page 1-4); comparing the customer's perception of the at least one attribute of information technology services with the different levels of maturity of the information technology service attribute; and providing a report with recommendations for improving the delivery of the at least one attribute

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of information technology services to the customer based on the comparison of the customer's perception with the different levels of maturity (pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter; Daskalantonakis, page 6, shows goal levels along with current levels; SCE, page 1-17 - attributes).

As per **claim 8**, SEI teaches the second assessment technique includes interviewing customers with detailed customers of at least one attribute of information technology services, the detailed questions having at least one focus area along with a set of descriptions and considerations, and an example for each focus area to determine an in depth assessment of the customer's perception and the current level of maturity of information technology services (SCE, p2-37 – site visit consists of interviews and developing exploratory questions; SCE, page 1-17 – attributes).

As per **claim 9**, SEI teaches the first assessment technique uses detailed matrices allowing identification of a current level of maturity of at least one service attribute and identification of a desired level of maturity of the at least one service attribute in a workshop approach with customers and the step of providing a report includes comparing the current levels of maturity with the desired level of maturity of information technology services for different aspects of information technology service delivery (Daskalantonakis, page 6, shows goal levels along with current levels; Daskalantonakis - page 1, pages 2; page 4 shows questions; SCE, page 1-7, maturity questionnaire; pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter).



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As per **claim 13**, SEI teaches a maturity level of the information technology service attribute comprises one of the following: ad hoc, repeatable, consistent, exceptional and world class (SCE, page 1-4 - initial (=ad hoc), repeatable, defined (=consistent), managed (=exceptional), and optimizing (=world class)).

As per claims **14-18**, SEI does not teach the assessment attribute is inventory control, financial reporting, payroll or computer-aided design and manufacturing (see SCE, page 1-17). However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

As per **claim 19**, SEI teaches the technology service attribute is definition and understanding of the information technology service (SCE, p 4-68, for each technical area within the attributes, a description is given.)

***Claim Rejections - 35 USC § 103***

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over SEI.

As per **claim 5**, SEI does not explicitly teaches the assessment matrix comprises no more than twenty information technology service attributes for a quick, general and/or a medium depth assessment. However it would have been obvious to one of ordinary skill in the art to select no more than twenty attributes for an assessment depending on the situation and as a matter of design choice. The selection of the number of attributes used for assessment will effect the accuracy of the assessment.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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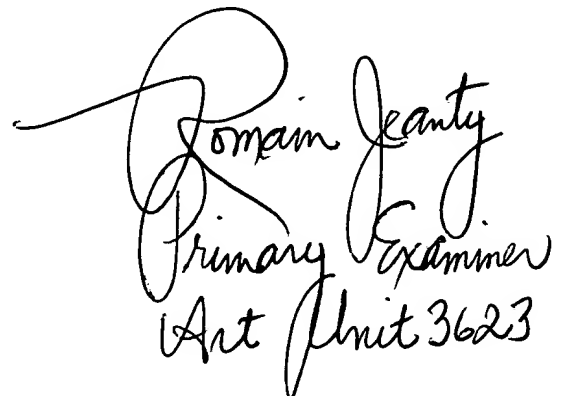
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL  
9/14/06



Romain Leanty  
Primary Examiner  
Art Unit 3623